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Amendment and/or Response
Reply to the Office Action of April 11, 2003

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REMARKS/DISCUSSION OF ISSUES

Status of the Claims

Claims 9-27 are pending in the present application, with claims 9-17 withdrawn from consideration at this time. Claim 18 the independent claim under present consideration.

Rejections

1. Claims 18-20 and 22-25 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over *Applicant's Prior Art Drawings* in view of *Fukui, et al.* (U.S. Patent 6,100,594). For the reasons set forth below, it is respectfully submitted that independent claim 18, and the claims that depend directly or indirectly therefrom are allowable over the applied reference.

The establishment of a *prima facie* case of obviousness requires that *all* of the elements be found in the prior art. It follows, therefore, if a single element is not found in the prior art, a *prima facie* case of obviousness cannot properly be established. Moreover, obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is a teaching, suggestion or motivation to do so found in the references relied upon. However, hindsight is never an appropriate motivation for combining references and/or the requisite knowledge available to one having ordinary skill in the art. To this end, relying upon hindsight knowledge of applicants' disclosure when the prior art does not teach nor suggest such knowledge results in the use of the invention as a template for its own reconstruction. This is wholly improper in the determination of patentability.

Claim 18 is drawn to a semiconductor device and includes the features:

"...a semiconductor element having a circuit forming surface;

a wiring disposed on said circuit forming surface and on a side surfac of

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said semiconductor element;...

It is respectfully submitted that *Applicant's Prior Art Drawings* lacks a disclosure of at least the featured wiring as set forth in claim 1. To this end, the Office Action asserts that *Applicant's Prior Art Drawings*, and in particular Figs. 21 and 22, which is referenced in the Office Action as disclose "...b) a wiring (604) disposed on said circuit forming surface and on a side surface..." (Please refer to page 3 of the Office Action.)

However, the re-wirings 604 of *Applicant's Prior Art Drawings* is disposed only on one surface of the structure as is shown in Fig. 21 in cross-section and as is shown in Fig. 22, which is a top view. As such, the re-wirings of *Applicant's Prior Art Drawings* are **not disposed on a side surface and on a circuit forming surface** as featured in independent claim 18.

In furtherance to this position, Applicants refer to the embodiment of Fig. 1. The circuit forming surface (upper side in the drawing) of a semiconductor element 101, has a **wiring** (or re-wiring) 104 disposed on **the circuit forming surface**. However, the wiring is also disposed **on the side surface** of the semiconductor element 101. Stated differently, the wiring of claim 18 is disposed on **two surfaces** of the semiconductor element, whereas the wiring 604 of *Applicant's Prior Art Drawings* is disposed **only on one surface** of the semiconductor element.

Accordingly, for the reasons set forth above, it is respectfully submitted that the applied art fails to disclose at least one of the features of claim 18. As such, a prima facie case has not been properly established. Therefore, and while in no way conceding as to the propriety of the rejection in view of *Fukui, et al.*, or the propriety of the combination of references, it is respectfully submitted that independent claim 18, and the claims that depend directly or indirectly therefrom are allowable over the applied art. Allowance is earnestly solicited.

2. Claim 21 was rejected under 35 U.S.C. § 103(a) as being unpatentable over

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Applicant's Prior Art Drawings in view of *Fukui, et al.* (U.S. Patent 6,100,594), and further in view of *Mori* (U.S. Patent 5, 903,049).

Claim 21 depends from claim 18, which, for the reasons set forth above, is believed to be allowable over the applied art. As such, and while in no way conceding as to the propriety of the rejection in view of *Mori* or the propriety of the combination of references, Applicants respectfully submit that claim 21 is allowable.

Conclusion

In view of the foregoing, applicant(s) respectfully request(s) that the Examiner withdraw the rejections of record, allow all the pending claims, and find the application to be in condition for allowance. If any points remain in issue that may best be resolved through a personal or telephonic interview, the Examiner is respectfully requested to contact the undersigned at the telephone number listed below.

Petition is hereby made for a two-month extension of time as provided under 37 C.F.R. § 1.136(a), extending the period of response from July 11, 2003 to September 11, 2003. Permission is hereby given to charge Deposit Account Number 50-0238 for the required fee under 37 C.F.R. § 1.17.

In the event that there are any outstanding matters remaining in the present application, the Examiner is invited to contact William S. Francos, Esq. (Reg. No. 38,456) at (610) 375-3513 to discuss these matters.

If necessary, the Commissioner is hereby authorized in this, concurrent, and further replies to charge payment or credit any overpayment to Deposit Account Number 50-0238 for any additional fees, including but not limited to, fees required under 37 C.F.R. §1.16 or under 37 C.F.R. §1.17.

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Respectfully submitted on behalf of:
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